

REMARKS

The above-referenced patent application has been reviewed in light of the Final Office Action, dated February 15, 2006, in which: claims 1-16 and 28-36 stand rejected under 35 USC 102 on US Patent No. 6,339,767 (hereinafter, "Rivette"). Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-16; 28-36; and 42-47 are pending. Claims 17-27 and 37-41 have been canceled in response to a restriction requirement from the Examiner. It is noted that no prosecution history estoppel necessarily results because Assignee retains the right to pursue these claims in a separate patent application. No claims have been amended. New claims 42-47 have been added.

As noted above, the Examiner has rejected claims 1-16 and 37-41 as unpatentable under 35 U.S.C. § 102 in view of Rivette. These rejections by the Examiner are respectfully traversed.

As is well-known, to establish a *prima facie* case of unpatentability under 35 U.S.C. § 102, the Examiner must establish that each and every element and limitation of the rejected claim is taught by the cited document. Assignee asserts that here the Examiner has failed to make the necessary showing.

As discussed in our prior response, with respect to the merits of the specific claim rejections, we begin by discussing claim 1. Here, the Examiner has failed to establish, for example, that the cited document satisfies the recited language of claim 1 directed to generating a search query.

In the Final Office action, dated February 15, 2006, the Examiner points to specific instances of language from the cited patent and states that "Applicant misinterpreted Examiner's statements." However, the portions cited demonstrate that Applicant did not misinterpret the Examiner.

The portions cited by the Examiner, and the figures cited by the Examiner, demonstrate clearly that Rivette does not "generate a search query..." In particular, for example, Rivette points to figure 53 and discusses in some detail, in columns 27 through 32, how the user interface works. It is clear from that description that it is the user that generates key words. For example, the patent states, at column 28, lines 16-17: "The user can search through patent bibliographic information by entering key terms..." It is clear throughout Rivette that the user produces the key terms. This is not what is claimed and described in the above-referenced patent application or meant by the language "generating a search query..."

While claimed subject matter is not limited to embodiments described in the specification; nonetheless, discussion of an embodiment from the specification may prove instructive in this context. Below are excerpts from the specification of the above-referenced patent application. Of course, claimed subject matter is not meant to be limited in scope to this particular example.

[0027] In one embodiment, the data retrieval element 18 parses the user query 42 to identify a plurality of keyword terms 44 such as those depicted in FIG. 2. As further shown in FIG. 2 the keyword terms 44 can be organized in the grid 40 along a set of horizontal and vertical paxes. For example, the user query Radio Frequency polymerization; use of radio waves to heat monomers and drive condensation polymerization.

[0028] This user query 42 can be subdivided in a plurality of key terms such as the key terms (radio and frequency); radio and wave; (polymer); (condens*); (condens*

and polymer*); (nylon); (head*). As shown in FIG. 2 each of these key terms 44 can be aligned along a respective portion of the horizontal or vertical axes to define the keyword grid 40. For each of the key phrases 44, the data retrieval element 18 may perform searches over the targeted databases 28 with these combinations. The resulting matches can be represented within the keyword grid 40 and then the system may perform analysis over the grid entries. For example, the system 10 may determine how many unique documents exist between two grid entries between the keyword 40, as many of the matches of both grid entries may be for the same document.

Again, this is merely an example embodiment and does not limit the scope of the claims. However, this example illustrates that the user does not generate the key words unlike in Rivette. It is, therefore, respectfully requested that the Examiner withdraw this rejection of claim 1 on these grounds.

The remaining rejected claims patentably distinguishable from Rivette at least on the same or a similar basis as claim 1. Thus, it is also requested that the Examiner withdraw the rejection of these remaining claims on this ground as well.

It is noted that new claims 42-47 have been added. Support is provided, for example, in paragraphs 26 to 29 of the above-referenced patent application. These claims depend from claim 1 or claim 28 and, therefore, patentably distinguish from Rivette on at least the same or similar basis as claim 1.

Attorney Docket 023.P016C2

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3130.

Respectfully submitted,



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Dated:

4/17/06

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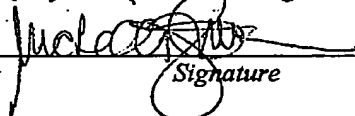
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